

REMARKS

I. Amendments to the Claims

Following entry of this amendment, claims 35-40, 44-47, 49-52, and 57-59 are pending. Claims 1-34, 41-43, 48 and 53-56 have been cancelled. Claim 35 is amended herein. Part of the amendment to claim 35 adds the letters "e" and "f" to show steps in the process, and support for that amendment is found generally throughout the original specification and claims.

Claim 35 is also amended to specify that chaotropic reagents are not used in the claimed invention. This change is supported throughout the specification as filed, and particularly in the third full paragraph beginning on page 5 of the English translation.

None of the amended or added claims include new matter. Entry and allowance of all of the amended claims are hereby requested.

II. Specification Objections

The Office Action objects to the disclosure as allegedly improper due to a typographical error, in particular the use of "PCT" in place of "PCR." The amendment correcting this has been made herein. One of skill in the art would recognize that this was an obvious typographical error, and correction of the error is supported by the original specification in its entirety as well as the use of "PCR" in the context of the paragraph where "PCT" mistakenly appeared. The applicant has also amended the same paragraph and the paragraph preceding it to move the word "Previous" to the proper paragraph.

The amendment to the specification includes no new matter, and its entry is requested.

III. Claim Rejections - 35 U.S.C. § 112

Claim 52 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for inclusion of "step (e)" in line 2 of the claim. This objection has been remedied by amendment of claim 35 to include a reference letter signifying "step (e)." Withdrawal of the rejection is requested.

IV. Claim Rejections - 35 U.S.C. § 102

Claims 35-40, 44-47, 50-52, and 57-59 stand rejected under 35 U.S.C. § 102(b) for alleged anticipation by United States Patent No. 6,218,531, to Ekenberg. Applicants respectfully disagree. For the claims to be anticipated by Ekenberg, Ekenberg must include, either expressly or inherently, all of the limitations in the claims. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Ekenberg does not teach all of the limitations of the amended claims; therefore it does not anticipate the present invention.

Ekenberg does not anticipate the pending claims, because Ekenberg does not expressly or inherently disclose the limitation of utilizing only non-chaotropic ions. To the contrary, all of the binding enhancers taught by Ekenberg include a chaotropic salt, and all of the processes taught by Ekenberg teach use of at least one chaotropic salt somewhere in the process.

The claimed invention has numerous advantages that are neither shared nor contemplated by the prior art. The toxic effects of the reagents are greatly reduced, and washing steps can be realized with an alcohol-free washing buffer or skipped altogether. Normally the step of removing the alcohol of the washing buffer is time-consuming and extensive, and the elimination of this step is a significant advance. This is different from Ekenberg, which requires that the

probes be washed several times (e.g. column 8, lines 31 and 46) and requires that the washing buffer be removed (column 8, line 4), because all of the washing buffers that are applicable to Ekenberg must contain alcohol to remove the chaotropic reagents (column 15, lines 50-65).

As Ekenberg does not explicitly or inherently disclose the limitation of excluding chaotropic salts, withdrawal of this rejection and allowance of the claims are respectfully requested.

CONCLUSION

Applicants believe that the amendments and remarks set forth in this paper place this Application in a condition for allowance, and such action is respectfully requested at an early date. If the Examiner believes that personal communication will expedite the prosecution of this Application, the Examiner is invited to telephone the Applicants' undersigned attorney directly.

Respectfully submitted,

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